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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,119	03/14/2001	Daisuke Yano	010324	6260
23850	7590	12/07/2006	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			RICKMAN, HOLLY C	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,119

Applicant(s)

YANO ET AL.

Examiner

Holly Rickman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The rejection of claims 1-5 and 12-16 under 35 U.S.C. 103(a) as being unpatentable over Hoppe (US 4852911) in view of Marechal et al (US 4899037) is withdrawn in view of Applicant's arguments. Hoppe fails to teach or suggest the use of a printed layer having a uniform thickness.

3. Claims 1-5 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. (US 4132350) in view of Marechal et al. (US 4899037).

Kubota et al. disclose a magnetic card and transfer tape wherein the magnetic card comprises a base layer structure, a magnetic layer, a masking layer for covering the magnetic layer, a printing layer formed from two different colors of ink having a uniform thickness and a protective layer thereon (see Fig 7; col. 3, line 20 to col. 4, line 27). The transfer sheet is formed from a backing layer 10, a protective layer, a printed layer having printed and non-printed regions of different colors wherein this layer has a uniform thickness 5, a color layer 4 and a magnetic layer 3 bonded to a layer 1b1 which corresponds to the claimed adhesive layer (See Fig 14). The reference is silent with respect to the claimed coercivity of the magnetic layer.

Marechal et al. teach that a suitable coercivity for a magnetic coating in a magnetic card structure is 300-600 Oe which reads on the claimed range.

It would have been obvious to one of ordinary skill in the art at the time of invention to choose an optimal coercivity value from within the range of 300-600 Oe taught by Marechal for use in the magnetic card and transfer tape structures taught by Kubota et al. in order to achieve the desired recording performance.

Response to Arguments

4. Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive.

Applicant argues that Kubota describes a formation method without the use of a transferring step. The examiner notes that Kubota clearly describe an embodiment of the invention use a transfer tape structure meeting the limitations of claims 1-5. See Fig 14 and description in columns 6-7.

Applicant argues that Kubota fails to disclose the importance or thickness uniformity in the printed layer. The examiner notes that the film thickness of the printed layer which includes printed and non-printed regions, corresponding to the claimed pattern printed region and filling layer region, is uniform as shown in the figures of Kubota. Applicant's attention is directed to figure no. 5 in Fig 14 for example. Thus, the examiner maintains that this claim limitation is met.

With regard to Marechal, Applicant argues that this reference does not relate to the object of the presently claimed invention because it does not discuss any problems with magnetic

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output variation cause by irregularities in the printed layer formed on a magnetic information layer.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is the examiner's contention that whether Marechal discusses the object of the presently claimed invention or not is irrelevant in the instant case. Marechal was cited because it suggests a desirable coercivity range for a magnetic recording tape in a magnetic card structure. Applicant's arguments do not appear to provide any reason why it would not have been obvious to combine the teachings of Kubota with the teachings related to coercivity set forth by Marechal.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman
Primary Examiner
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